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10/578,697	05/09/2006	Andrew Strawn	852.0103.U1(US)	3700
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EXAMINER				
GALKA, LAWRENCE STEFAN				
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3714				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/578,697

Applicant(s)

STRAWN ET AL.

Examiner

LAWRENCE GALKA

Art Unit

3714

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 August 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) 20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-19 and 21-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 August 2009 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/S508)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

1. Applicants' submission of a response on 8/24/09 has been received and considered. In the response, applicants amended claims 1-19 and 21-30 and cancelled claim 20. Therefore, claims 1-19 and 21-30 are pending. In addition, applicants have provided 2 revised drawing sheets containing Figures 3A, 3B, 4A, 4B and 4C which have been approved for entry. Further, the applicants have provided 4 replacement paragraphs for the specification on pages 4, 6, 7, 8 which are approved for entry. Applicants refer to an IDS filed on 8/6/07 but examiner has no record of this document and therefore it has not been considered.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claim 15 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Regarding claim 15, applicant has recited the negative limitation "without longitudinally moving the upper portion relative to the lower portion" but support for this negative limitation is not found in the specification.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1-9, 14, 16-19, 21-24, and 29 are rejected under 35 U.S.C. 102(b) as being anticipated by Sawyer (pat. no. 6,433,777 B1).
6. Regarding claim 1, Figs. 3B-3E, 4B and 4C of Sawyer disclose *a user input device comprising an extendible support (316, 412) having at a first end a tactile member for user actuation (122) and mounted at a second end for pivotal movement (from col. 5, line 66 to col. 6, line 1), wherein the user input device has a first configuration in which the extendible support is retracted and a second configuration in which the extendible support is extended, wherein in the second configuration the user input device is operable as a joystick game controller (col. 5, lines 57-65), wherein the extendible support comprises an upper portion (332) and a lower portion (314), wherein the upper and lower portions are sized and shaped to be locked in the first configuration until the upper portion is manually directly axially rotated by a user relative to the lower portion (user pushes down on second segment causing latch member to rotate and move tabs from beneath guides thereby unlocking the first and second segments; see col. 7, lines 30-41).*
7. Claims 2-9 are rejected for the same reasons as given in the previous office action.
8. Regarding claim 14, Figs. 3B-3E, 4B and 4C of Sawyer disclose *a user input device comprising an extendible support (316, 412) having at a first end a tactile member for user*

actuation (122) and mounted at a second end for pivotal movement (from col. 5, line 66 to col. 6, line 1), wherein the user input device has a first configuration in which the extendible support is retracted and a second configuration in which the extendible support is extended, wherein in the second configuration the user input device is operable as a joystick game controller (col. 5, lines 57-65), wherein the extendible support comprises an upper portion (332) and a lower portion (314), wherein the upper and lower portions are sized and shaped to be locked in the first configuration until the upper portion is manually directly axially rotated by a user relative to the lower portion (user pushes down on second segment causing latch member to rotate and move tabs from beneath guides thereby unlocking the first and second segments; see col. 7, lines 30-41).

9. Regarding claim 16, Figs. 3B-3E, 4B and 4C of Sawyer disclose *a user input device comprising an extendible support (316, 412) having at a first end a tactile member (122) for user actuation and mounted at a second end for pivotal movement (from col. 5, line 66 to col. 6, line 1), wherein the user input device has a first operational configuration in which the extendible support is retracted and a second operational configuration in which the extendible support is extended, wherein the user input device functions as an input device in both first and second operational configurations (see Figs. 3D and 3E; col. 5, lines 57-65), wherein the user input device comprises means for extending the extendible support in response to a first user action and for retracting the extendible support in response to a reversal of the first user action (user extends by rotating tabs from under the guides and retracts by rotating tabs under the guides; see col. 7, lines 30-33 and 21-23).*

10. Claims 17-19, 21-24 and 29 are rejected for the same reasons as given in the previous office action.

Claim Rejections - 35 USC § 103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

13. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

14. Claim 1, 10, 11, 14, 16, 25-26 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lection et al. (pat. no. 6,198,472 B1) in view of Hamilton (pat. no. 4,819,137).

15. Regarding claim 1, Figs. 4B and 5B of Lektion et al. discloses *a user input device comprising an extendible support (105) having at a first end a tactile member (108) for user actuation and mounted at a second end for pivotal movement* (col. 4, lines 16-20; col. 6, lines 28-34), *wherein the user input device has a first configuration in which the extendible support is retracted and a second configuration in which the extendible support is extended* (col. 4, lines 32-35; col. 6, lines 31-34), *wherein in the second configuration the user input device is operable as a joystick game controller* (col. 4 lines 58-67; col. 6, lines 34-39 and 60-63). It is noted that Lektion does not explicitly disclose *the upper and lower portions are sized and shaped to be locked in the first configuration until the upper portion is manually directly axially rotated by a user relative to the lower portion*. Hamilton, however, teaches of a telescoping apparatus that is released by a user rotating the tip to release a bayonet type latch (col. 4, lines 42-50). Therefore, it would have been obvious to a person having ordinary skill in the art at the time of the invention to modify the Lektion invention to use the latching mechanism as taught by Hamilton. The Hamilton latch would prevent unwanted telescoping of the apparatus by accidental compression of the telescoping portions.

16. Claims 10-11 are rejected for the same reasons as given in the previous office action.

17. Regarding claim 14, Figs. 4B and 5B of Lektion et al disclose *a user input device comprising an extendible support (105) having at a first end a tactile member (108) for user actuation and mounted at a second end for pivotal movement* (col. 4, lines 16-20; col. 6, lines 28-34), *wherein the user input device has a first configuration in which the extendible support is retracted and a second configuration in which the extendible support is extended* (col. 4, lines 32-35; col. 6, lines 31-34), *wherein in the second configuration the user input device is operable*

as a joystick game controller (col. 4 lines 58-67; col. 6, lines 34-39 and 60-63). It is noted that Lektion does not explicitly disclose *the upper and lower portions are sized and shaped to be locked in the first configuration until the upper portion is manually directly axially rotated by a user relative to the lower portion*. Hamilton, however, teaches of a telescoping apparatus that is released by a user rotating the tip to release a bayonet type latch (col. 4, lines 42-50). Therefore, it would have been obvious to a person having ordinary skill in the art at the time of the invention to modify the Lektion invention to use the latching mechanism as taught by Hamilton. The Hamilton latch would prevent unwanted telescoping of the apparatus by accidental compression of the telescoping portions.

18. Regarding claim 16, Figs. 4B and 5B of Lektion et al teaches *a user input device comprising an extendible support (105) having at a first end a tactile member for user actuation (108) and mounted at a second end for pivotal movement* (col. 4, lines 16-20; col. 6, lines 28-34), *wherein the user input device has a first operational configuration in which the extendible support is retracted and a second operational configuration in which the extendible support is extended* (col. 4, lines 32-35; col. 6, lines 31-34), *wherein the user input device functions as an input device in both first and second operational configurations* (col. 4, lines 30-35). It is noted that Lektion does not explicitly disclose *extending the extendible support in response to a first user action and for retracting the extendible support in response to a reversal of the first user action*. Hamilton, however, teaches of a telescoping apparatus that is released by a user rotating the tip to release a bayonet type latch and reversing the rotation (col. 4, lines 42-50 and lines 32-37). Therefore, it would have been obvious to a person having ordinary skill in the art at the time of the invention to modify the Lektion invention to use the latching mechanism as taught by

Hamilton. The Hamilton latch would prevent unwanted telescoping of the apparatus by accidental compression of the telescoping portions.

19. Claims 25 and 26 are rejected for the same reasons given in the previous office action.

20. Regarding claim 29, 4B and 5B of Lektion et al teaches *a user input device comprising an extendible support (105) having at a first end a tactile member for user actuation (108) and mounted at a second end for pivotal movement (col. 4, lines 16-20; col. 6, lines 28-34), wherein the user input device has a first operational configuration in which the extendible support is retracted and a second operational configuration in which the extendible support is extended (col. 4, lines 32-35; col. 6, lines 31-34), wherein the user input device functions as an input device in both first and second operational configurations (col. 4, lines 30-35)*. It is noted that Lektion does not explicitly disclose *extending the extendible support in response to a first user action and for retracting the extendible support in response to a reversal of the first user action*. Hamilton, however, teaches of a telescoping apparatus that is released by a user rotating the tip to release a bayonet type latch and reversing the rotation (col. 4, lines 42-50 and lines 32-37). Therefore, it would have been obvious to a person having ordinary skill in the art at the time of the invention to modify the Lektion invention to use the latching mechanism as taught by Hamilton. The Hamilton latch would prevent unwanted telescoping of the apparatus by accidental compression of the telescoping portions.

21. Claim 30 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sawyer et al. (pat. no. 6,433,777 B1) in view of Hamilton (pat. no. 4,819,137).

22. Regarding claim 30, Figs. 3B-3E, 4B and 4C of Sawyer shows *a user input device, for an electronic device, comprising: an extendible support (316, 412) having at a first end a tactile*

member (122) for user actuation and mounted for pivotal movement (from col. 5, line 66 to col. 6, line 1) about a second end, wherein the user input device has a first operational configuration in which the extendible support is retracted and a second operational configuration in which the extendible support is extended, wherein the user input device functions as an input device in both first and second operational configurations (see Figs. 3D and 3E; col. 5, lines 57-65). It is noted that Sawyer does not disclose *a direct manual rotation of the tactile member by a user's hand about an axis of extension of the extendible support.* Hamilton, however, teaches of a telescoping apparatus that is released by a user rotating the tip to release a bayonet type latch (col. 4, lines 42-50). Therefore, it would have been obvious to a person having ordinary skill in the art at the time of the invention to modify the Sawyer invention to use the latching mechanism as taught by Hamilton. The Hamilton latch would prevent unwanted telescoping of the apparatus by accidental compression of the telescoping portions.

23. Claims 10, 11, 25 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sawyer (pat. no. 6,433,777 B1) in view of Lection et al. (pat. no. 6,198,472 B1).

24. Claims 10, 11, 25 and 26 are rejected for the same reasons given in the previous office action.

25. Claims 12 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sawyer (pat. no. 6,433,777 B1) in view of Oueslati et al. (pat. no. 6,806,865 B2).

26. Claims 12 and 27 are rejected for the same reasons as given in the previous office action.

27. Claims 13 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sawyer (pat. no. 6,433,777 B1) in view of Oueslati et al. (pat. no. 6,806,865 B2) and further in view of Peng (pub. no. 2003/0052861 A1).

28. Claims 13 and 28 are rejected for the same reasons as given in the previous office action.

29. Claims 12 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lection et al. (pat. no. 6,198,472 B1) and Hamilton (pat. no. 4,819,137) in view of Oueslati et al. (pat. no. 6,806,865 B2).

30. Regarding claims 12 and 27, it is noted that the teachings of Lection et al. and Hamilton do not disclose *an electronic gaming device that is pocket sized and for handheld use*. However, Oueslati et al. teaches of a joystick on a handheld computer (from col. 1, line 63 to col. 2, line 4). Hence, it would have been obvious to one of ordinary skill in the art to modify the device of Lection et al. and Hamilton with the features of the electronic gaming device is pocket sized and for handheld use as taught by Oueslati et al. Using the Lection/Hamilton/Oueslati input device on a mobile phone would allow gaming while on public transportation or when traveling.

31. Claims 13 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lection et al. (pat. no. 6,198,472 B1) and Hamilton (pat. no. 4,819,137) in view of Oueslati et al. (pat. no. 6,806,865) and further in view of Peng (pub. no. 2003/0052861 A1).

32. Regarding claims 13 and 28, it is noted that that the teachings of Lection and Hamilton and Oueslati et al. do not disclose *an electronic gaming device further operable as a mobile cellular telephone*. However, Peng teaches a joystick on a mobile cellular telephone ([0015]). Hence, it would have been obvious to one of ordinary skill in the art to modify the device of Lection and Hamilton and Oueslati with the features of the electronic gaming device further operable as a mobile cellular telephone as taught by Peng. Using the Lection/Hamilton/Oueslati input device on a mobile phone would allow gaming while on public transportation or when traveling.

Response to Arguments

33. Applicants' arguments filed on August 24, 2009 have been fully considered but they are not entirely persuasive.
34. Examiner cannot find any reference to an Information Disclosure Statement filed on 8/6/07. As a result, references cited therein have not been considered and no form PTO 1449 is being forwarded.
35. The replacement drawings containing Figures 3A, 3B, 4A, 4B and 4C are accepted and the objections to the drawings have been withdrawn.
36. The 4 replacement paragraphs for the specification on pages 4, 6, 7, 8 are accepted. Examiner agrees with applicants' arguments concerning the national stage application. As a result the objections to informalities in the specification are withdrawn.
37. The rejection to claims 1-14, 22-24 and 29 under 35 USC §112, second paragraph have been withdrawn based on the current amendments to those claims.
38. On page 14, applicants argue that amended claim 1 is not anticipated by Sawyer because Sawyer does not disclose manually directly axially rotating an upper portion. Examiner respectfully disagrees. The ball-point-pen-like device contains a latch member (Fig. 3D, 332) which is manually directly axially rotated. Manually, because a finger push is the force that causes the rotation without any assistance from a motor. Directly, because there is no delay between the pushing of the upper portion and the rotation about its axis.
39. Examiner has noted that Lektion does not explicitly disclose manually directly axially rotating an upper portion. Claim 1 has been rejected as obvious over Lektion in view of Hamilton as detailed above.

40. On page 14 and 15, applicants argue that Sawyer does not disclose a reversal of a user action to retract. Examiner respectfully disagrees. First, such limitation is not included claim 1. Next, the latch member (Fig. 3D, 332) is rotated one direction when user is pushing down on the upper segment and in the opposite direction when the user allows the upper segment to rise. Rotating in one direction moves the tabs under the channel and latches. Rotating in the other direction moves the tabs out from under the channel and releases. This push / release pair of actions constitutes a reversal of user actions.

41. On page 15, applicants argue that amended claim 15 is not anticipated by Sawyer or Lection because of the negative limitation "without longitudinally moving the upper portion relative to the lower portion". Examiner agrees. However, there is no support for such a limitation in the specification and such a limitation is obvious in light of the teachings of Hamilton as discussed above.

42. On page 16, applicants argue that amended claim 16 is not anticipated by Sawyer or Lection because they do not disclose a reversal of a user action to retract. Examiner respectfully disagrees. In Sawyer, the latch member (Fig. 3D, 332) is rotated one direction when user is pushing down on the upper segment and in the opposite direction when the user allows the upper segment to rise. Rotating in one direction moves the tabs under the channel and latches. Rotating in the other direction moves the tabs out from under the channel and releases. This push / release pair of actions constitutes a reversal of user actions. Examiner has noted that Lection does not explicitly disclose a reversal of a user action to retract. Claim 16 has been rejected as obvious over Lection in view of Hamilton as detailed above.

43. On pages 16-17, applicants argue that amended claim 30 is not anticipated by Sawyer because it does not disclose manually rotating a tactile member. Examiner agrees. However, such a limitation is obvious in light of the teachings of Hamilton as discussed above.

Conclusion

44. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Gross et al. (pub. no. 2003/0206151 A1) discloses an input device for a mobile computing device.

45. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to LAWRENCE GALKA whose telephone number is (571) 270-1386. The examiner can normally be reached on M-Th 7:30-5, every other F 7:30-4.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dmitry Suhol can be reached on (571) 272 4430. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/JAMES S. MCCLELLAN/
Primary Examiner, Art Unit 3714

LSG 11/20/09